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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,716	10/27/2003	Jeff Ciarlo	0903	1584

2609 7590 02/13/2006

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EXAMINER

LE, TAN

ART UNIT PAPER NUMBER

3632

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/693,716	CIARLO, JEFF	
	Examiner	Art Unit	
	Tan Le	3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the fourth office action for Application No. 10/693,716. This application currently contains 3 claims numbered 1, 8 and 9. Claims 2-7 have been canceled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1, 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 9 are rejected because there is inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear. Applicant is required to clarify what the claim is intended to be drawn to i.e, either a post protector alone or the combination of the post protector and a post (see phrase " barrier rear portion having an extended support portion *extending horizontally rearwardly beyond the post* " (claim 1, lines 12-14, for example) or (see the phrase "a front member and at least one rear member having vertically disposed segments integrally connected to each other *extending upwardly from the support surface around and spaced from all sides of the post*" (claim 9, lines 3-5, for example) and the language of the claim be consistent with the intent. In formulating a rejection on the merits, the examiner is considering that the claim is drawn to the combination.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,088,229 to Jacoby et al.

As to claim 1, claim 1 reads on Jacoby et al. as follows: a barrier (Fig. 5 for example) having contiguous front and rear portions defining a certain size interior enclosure; the barrier rear portion has an extended support portion extending horizontally rearwardly beyond the post (17), the barrier also having a securing means (35a) interior thereto and adjacent the barrier extended rear portion and the post; the barrier also having resistively flexible oblique vertical bends (45a, 46a, 47 for example) between front panel portion and the respective rear support portions adjacent extended side support portions.

As to claim 8, claim 8 also reads on Jacoby as follows: a securing means (48, 49) between the barrier rearwardly extending portions with a central beam portion (35) at a bottom of the rearward barrier portion positioned between and adjacent the rearward portions thereof and secured to respective rearwardly extended rear portions.

As to claim 9, the claim 9 reads on Jacoby as follows: a post protector comprising a front vertical member (45c) and at least one rear vertical member (45b) integrally connected to each other extending upwardly from a support surface and disposed substantially around and spaced from the post (17), wherein the front vertical member includes upright segments (45a, 45c, 46a, 46c) having at least one support

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surface engagement portion (area of 35a generally or 46c for example) extending intermediate the upright segments and the post and engaging the support surface between the upright segments and the post, and flexible bending element in the upright segments capable of moving away from the post when the front vertical member is deflected toward the post; and wherein the rear vertical member has a support surface engagement portion (area of 48, 49 for example) spaced apart from the post and engaging the support surface at a distance from the post on a side of the post opposite from the support surface engagement portion of the front vertical member.

Response to Arguments

4. Applicant's arguments filed 11/25/05 been fully considered but they are not persuasive.

Applicant has further amended independent claim 1 and independent claim 9 and pointed to alleged differences between the prior art and his invention based upon amendment introduced into claims. However, these claims still stand rejected as being anticipated by Jacoby et al. Claims 1 and 8-9 as amended are now broader than the previous claims. Instead of making claims narrower, Applicant has presented the claims that are broader and are rejected as being inconsistency between the language of the preamble and a portion of the body claims therefore making the claims unclear.

Applicant appears to rely on languages such as "adapted to be position horizontally around and spaced away from all sides of the post..." or "adapted to enclose the post and provide complete spacing of said barrier away from the post..." as argued by

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Applicant on pages 6-8). These languages are functional languages. It has been held that the recitation that an element is "adapted to" perform a function is not positive limitation by only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. In the instant case, the structure of the prior art clearly can be adapted to perform such function. Other arguments appear to be repeated and these arguments have been addressed in the previous office action.

Conclusion.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (571) 272-6818. The examiner can normally be reached on Mon. through Fri. from 9:00 AM-6:00 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tan Le
January 27, 2006.



ANITA KING
PRIMARY EXAMINER